

REMARKS

Claims 1-44 are pending in the application. Claims 25-40 have been withdrawn from consideration. Claims 1-24 and 41-44 have been rejected.

Applicant respectfully requests reconsideration of the present application and withdrawal of the rejections in light of the following remarks.

35 USC §102(b) Rejections:

A. Claims 1-11, 21, 23, 41 and 43 have been rejected under 35 U.S.C. §102(b) as being anticipated by MacGregor et al. (US 4,846,504). The Examiner contends that MacGregor discloses a label assembly comprising a backing tape with a release layer, bearing a series of labels, wherein each of the labels are formed of a base label, a promotional label and an outer label. The Examiner also contends that MacGregor teaches the promotional label is formed of water-resistant material, and the peeling force of the removable or resealable adhesive covering the promotional label is approximately 0.7 lbs/in or 0.9 lbs/in, which reads on the instantly claimed range of at least about 0.25 N/25mm at a test plate temperature of 5°C. Further, the Examiner contends that MacGregor teaches an adhesive comprising the same chemical component as disclosed in Applicant's specification, thus MacGregor's adhesive would inherently have the same properties as Applicant's.

Applicant respectfully disagrees with the Examiner's contentions. The purpose of the label of MacGregor is to provide tamper resistance and to secure a promotional coupon to a package. A water resistant coupon is secured to a package by a water soluble adhesive. To remove the coupon, the purchaser runs water over the coupon (col. 1, lines 54-59). In the embodiment referenced by the Examiner, the label consists of a base sheet permanently adhered to the package and a coupon (or game piece) lightly adhered to the base sheet by a non-permanent pressure sensitive adhesive. The coupon is concealed by a third outer layer secured to the assembly by a permanent, water soluble adhesive, for removal at home by the purchaser. (Figure 1).

MacGregor discloses that the outer layer 24 is adhered with a permanent, water soluble adhesive; that the promotional layer 22 is "lightly adhered" to the base layer 20; and that the base layer 20 is secured with a permanent pressure sensitive adhesive.

"The lower surface of the top label 24 is provided with a pressure-sensitive, permanent, water soluble adhesive to secure the outer label portion 24 to the base portion 20 of the three thickness label 16." (col. 3, lines 22-26.)

"Concerning the adhesive employed to secure the promotional layer 22 to the base layer 20, this may be accomplished with a coating which is transparent, and which lightly adheres the promotional layer 22 to the base label 20, *but is non-tacky*. A suitable coating for this purpose would be an emulsion latex polymer coating. It is transparent, non-tacky, peelable, and has low adhesion." (col. 4, lines 17-24.)

The Examiner stated that "the peeling force of the removable or resealable adhesive covering the promotional label is approximately 0.7 lbs/in or 0.9 lbs/in" and has referred to col. 3, lines 55-65 and col. 4, lines 4-7. However, it is clear from the specification of MacGregor, that the adhesive covering the promotional label is a permanent, water-soluble adhesive. The outer label of the MacGregor construction is removed using water to expose the coupon or game piece (col. 1, lines 54-60; col. 3, lines 38-42; col. 6, lines 2-7).

With regard to the Examiner's assertion that MacGregor teaches the removable and resealable adhesive to be acrylic-based or rubber-based hot melt pressure sensitive adhesive and that such adhesives would inherently have the same properties, such as the peeling force and cohesive strength, Applicant respectfully submits that the Examiner has not provided a basis in fact and/or technical reasoning to reasonably support a determination that the allegedly inherent characteristics necessarily and inevitably flow from the teachings of the MacGregor. Ex parte Levy, 17 USPQ 2d 1461 (BPAI 1990). It is well known that when a prior art reference does not expressly set forth a particular element of the claim, the reference may still anticipate if that element is "inherent" in its

disclosure. However, as noted by the Federal Circuit in In re Robertson, 49 USPQ 2d 1949, 1950 (Fed. Cir. 1999),

To establish inherency, the extrinsic evidence “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill” Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268, 20 USPQ 2d 1747, 1749 (Fed. Cir. 1991).

Inherency however, may not be established by a probability or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id* at 1269, 20 USPQ 2d at 1749 (quoting In re Oelrich, 666 F2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

Copies of the cases cited above are attached for the Examiner's convenience.

MacGregor does not disclose removable, resealable adhesives having a Moist Loop Test result of at least about 0.25 N/25mm at a test plate temperature of 5°C, or a cohesive strength of less than about 250,000 at 5°C. Rather, MacGregor teaches away from such an adhesive since the object of MacGregor is to provide a tamper resistant coupon that is adhered to a package in such a way as to be removable only by the application of water, which is generally not present at the purchase site. (Col. 1, lines 54-65.) The adhesives of MacGregor do not necessarily and inevitably possess the claimed properties of Applicant's removable and resealable adhesive. Accordingly, MacGregor does not anticipate the adhesive article of claims 1-11, 21, 23, 41 and 43. Withdrawal of the rejection of Applicants' claims 1-11, 21, 23, 41 and 43 as anticipated by MacGregor is believed to be warranted and is respectfully requested.

B. Claims 1-3, 8-11, 18-24 and 41-44 have been rejected under 35 U.S.C. §102(b) as being anticipated by Sorensen et al. (US 4,771,891). The Examiner contends that Sorensen teaches the adhesive to be acrylic-based,

rubber-based or hot melt pressure sensitive and that it has a peeling force of approximately 0.7 lbs/in and 0.9 lbs/in, which reads on the instantly claimed range of at least about 0.25 N/25mm at a test plate temperature of 5°C. Further, the Examiner contends that Sorensen teaches an adhesive comprising the same chemical component as disclosed in Applicant's specification, thus Sorensen's adhesive would inherently have the same properties as Applicant's adhesive.

Applicant respectfully disagrees with the Examiner's contentions. Sorensen teaches the use of variable patterns of a single adhesive to achieve both a permanent bond in one area and a removable bond in another area of the label (col. 1, lines 49-52). The label is disclosed as being useful for application to boxes having a U-shaped perforation in the box that forms a pouring flap. The label is permanently adhered to the box and the pattern of adhesive permits the reclosing or resealing of the flap between uses (col. 2, lines 24-31). Sorensen teaches that a permanent adhesive is preferred (col. 4, lines 38-39). The permanent adhesive is patterned on one area of the label in order to reduce the peel strength of the permanent adhesive (col. 5, lines 30-50). Sorensen teaches that a rubber based, hot melt permanent adhesive is preferred (Fig. 4, col. 5, lines 26-30).

Applicant respectfully submits that the Examiner has not provided a basis in fact and technical reasoning to support a determination that the allegedly inherent characteristics necessarily and inevitably flow from the teachings of Sorensen. Accordingly, Sorensen does not anticipate the adhesive article of claims 1-3, 8-11, 18-24 and 41-44. Withdrawal of the rejection of claims 1-3, 8-11, 18-24 and 41-44 as anticipated by Sorensen is respectfully requested.

C. Claims 1-5, 9-10, 12-18, 21-22 have been rejected under 35 U.S.C. §102(b) as being anticipated by Cameron et al. (US 6,025,071). The Examiner contends that Cameron teaches an adhesive article, comprising a substrate and a removable and resealable adhesive coated on the surface of the substrate. The Examiner also contends that the adhesive comprises about 10-50% by weight of a styrene-isoprene-styrene block copolymer; about 10-40% by weight

of a tackifying resin; and about 10-50% by weight of plasticizers. The Examiner admits that Cameron fails to teach the peel force and cohesive strength as claimed by Applicants, but contends that such properties are inherent.

Applicant respectfully disagrees with the Examiner's contentions. Cameron discloses removable, hot melt pressure sensitive adhesives that typically have low peel adhesion (col. 1, lines 42-43). Cameron discloses that there are many problems to overcome in developing removable grade hot melts (col. 1, line 60 to col. 2, line 3). Specifically, a first problem to overcome is poor adhesion to the substrate to which the adhesive is applied in its molten state (col. 2, lines 13-16). Another problem is poor stain resistance (col. 2, lines 26-27). Yet another problem is the build in adhesion over time, which can ultimately destroy the removability, causing undesirable substrate failure and adhesive residue (col. 2, lines 57-60). Cameron teaches an adhesive formulated specifically to achieve excellent anchorage, excellent quick tack, and excellent stain resistance, while retaining a low viscosity and low ultimate peel adhesion (col. 3, lines 12-17). Cameron asserts that it is difficult to formulate such adhesives to achieve a good balance of desirable properties without sacrificing one property to another (col. 2, lines 1-3).

Cameron does not disclose, teach or suggest formulating a removable and resealable adhesive. Even further, Cameron does not disclose, teach or suggest how to formulate a removable and resealable adhesive having a Moist Loop Tack at 5°C of at least 0.25N/25mm or a cohesive strength of less than about 250,000 at 5°C. These adhesive characteristics are not considered by Cameron, as Cameron is concerned with the characteristics of anchorage, quick tack, and stain resistance. Applicant respectfully submits that the Examiner has not provided a basis in fact and technical reasoning to support a determination that the allegedly inherent characteristics necessarily and inevitably flow from the teachings of Cameron. As discussed above, inherency must flow as a necessary conclusion from the prior art, not simply a possible one. Accordingly, Cameron does not anticipate the adhesive articles of claims 1-5, 9-10, 12-18, 21-22. Withdrawal of the rejection of Applicants' claims 1-5, 9-10, 12-18, 21-22 as

anticipated by Cameron is believed to be warranted and is respectfully requested.

35 USC §103(a) Rejections:

A. Claims 12-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sorensen et al. and further in view of Cameron et al. (US 6,025,071). The Examiner contends that Cameron teaches an article having a removable hot melt pressure sensitive adhesive comprising a mixture of styrene-isoprene-styrene triblock and diblock copolymers, and at least one tackifying resin, such as terpene and rosin. Therefore, the Examiner contends that it would have been obvious to one of ordinary skill in the art to have employed the adhesive taught by Cameron in the adhesive composition of Sorensen, because Cameron discloses that the use of this adhesive composition would have resulted in excellent anchorage of the adhesive to the substrate, excellent quick tack and stain resistance, while retaining a low viscosity and low ultimate peel adhesion.

Applicant respectfully disagrees with the Examiner's contentions. As stated above, there is no disclosure, teaching or suggestion within Sorensen of an adhesive label being removable and resealable and having a Moist Loop Test result of at least about 0.25 N/25mm at a test plate temperature of 5°C, nor is this characteristic inherent. Furthermore, Cameron does not correct the deficiencies of Sorensen. Cameron discloses the many difficulties in formulating removable hot melt adhesives and obtaining adhesives with the proper balance of properties. Neither Sorensen nor Cameron teach or suggest all of the limitations of the claims. Applicants' respectfully request withdrawal of the rejection of claims 12-17 under 35 U.S.C. §103(a).

B. Claims 4-7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sorensen et al. and further in view of MacGregor. The Examiner contends that MacGregor teaches paper coated with varnish, or plastic films, such as polystyrene, polypropylene or polyethylene. Therefore, the Examiner contends that it would have been obvious to one of ordinary skill in the

art to have employed the substrate as a plastic film comprising polystyrene, polypropylene or polyethylene as taught by MacGregor, in the adhesive article of Sorensen, which would give the same results because MacGregor discloses that the adhesive could be used on a paper coated with varnish or plastic films.

Applicant respectfully disagrees with the Examiner's contentions. As stated above, there is no teaching or suggestion within Sorensen of an adhesive label being resealable under moisture condensation conditions as measured by a Moist Loop Test result of at least about 0.25 N/25mm at a test plate temperature of 5°C, nor is the Moist Loop Test results inherent. Further, MacGregor does not correct the deficiencies of Sorensen, i.e., the addition of the substrate as a plastic film comprising polystyrene, polypropylene or polyethylene as disclosed in MacGregor would not produce Applicant's claimed adhesive article.

Accordingly, Applicants' respectfully request withdrawal of the rejection of claims 4-7 under 35 U.S.C. §103(a).

Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and a timely issuance of a notice of allowance for claims 1-24 and 41-44.

In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 under Attorney Docket No. **VERP3447USA**.

Respectfully submitted,

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